

REMARKS

Claims 1, 2, 6, 12, 17, 21, and 22 are amended. No new subject matter is added. Claims 1-24 remain pending in the application. Reconsideration and allowance of the pending claims is requested in light of the following remarks.

IN THE CLAIMS

The amendment of claim 1 is fully supported in the application as filed at, e.g., page 2, lines 2-3. Since claim 1 is amended only to clarify the meaning of “ARPA”, the amendment of claim 1 is not one which requires further consideration and/or search.

Claims 2, 6, and 12 are amended for consistency with claim 1.

The amendments to claims 17, 21, and 22 are fully supported in the application as filed at, e.g., page 17, lines 17-20.

CLAIM OBJECTIONS

Claims 1-16 are objected to because of informalities.

Regarding claim 1, the claim has been amended to comply with the requirements of the Office Action.

Regarding claims 2, 6, and 12, the claims have been amended to be consistent with the terminology of claim 1.

Regarding claims 3-5, 7-11, and 13-16, the applicant does not agree that these claims need to be amended. Proper antecedent basis for “ARPA” is provided in claim 1. Therefore amendment of the remaining claims reiterating the full name rather than the abbreviation should not be required.

CLAIM REJECTIONS – 35 USC § 102

Claims 17-24 are rejected under 35 USC 102(e) as being anticipated by U.S. Pat. No. 6,356,356 to Miller (“Miller”). The applicant disagrees.

Regarding claims 17, 21, and 22, the claims recite that the destination fax number is obtained independent of the email message. Miller teaches exactly the opposite of this feature. In Miller, the destination fax number comes directly from the email. See Miller column 7, lines 56-58. Further, the device of Miller could not determine a destination fax number independently

from the email because the email itself is sent to an email address specifying the machine, not the intended recipients of the fax. See Miller column 7, lines 41-43. Consequently, Miller does not anticipate claims 17, 21, and 22 because it fails to show the identical invention in as complete detail as contained the claims. MPEP 2131.

Regarding claims 18-20, 23, and 24, these claims depend from claims 17 and 22 and are not anticipated by Miller for at least the same reasons that Miller does not anticipate claims 17 and 22.

Further regarding claims 18 and 23, the claims recite receiving a reply from the fax recipient in the form of a reply fax document. Miller does not teach or suggest that any reply is received from a fax recipient, much less in the form of a fax document. For this additional reason, Miller fails to anticipate claims 18 and 23.

Further regarding claims 19 and 24, the claims recite verifying a destination user address for identifying the fax recipient as being a known user. Miller does not teach or suggest that the destination user is verified as a known user. The only verification steps in Miller involve verification of senders as authorized users. See Miller column 7, lines 46-54. For this additional reason, Miller fails to anticipate claims 19 and 24.

CLAIM REJECTIONS – 35 USC § 103

Claims 1-16 are rejected under 35 USC 103(a) as being unpatentable over Miller in view of U.S. Pat. No. 6,411,685 to O’Neal (“O’Neal”). The applicant disagrees.

Regarding claim 1, the claim recites “a fax number designating the fax recipient is obtained independently of the e-mail.” As addressed above for claims 17, 21, and 22, Miller does not teach that the recipient fax number is obtained independently of the email. O’Neal does not remedy this deficiency. Consequently, the combination of Miller and O’Neal fails to establish *prima facie* obviousness for claim 1 because it does not teach or suggest all of the features recited in the claim. MPEP 2143.03.

Claims 2-16 depend from claim 1, and inherently contain the features of claim 1. Consequently, claims 2-16 are allowable over the combination of Miller and O’Neal at least because any claim that depends from a non-obvious independent claim is also nonobvious. MPEP 2143.03.

Further regarding claims 2, 3, 5, 9, 13, and 14, the claims recite various functionalities associated with the storage device. Miller does not teach a storage device and the storage device 118 of O'Neal contains none of the functionalities recited in claims 2, 3, 5, 9, 13, and 14. See O'Neal column 5, lines 30-31 and FIG. 1. For these additional reasons, claims 2, 3, 5, 9, 13, and 14 are allowable over the combination of Miller and O'Neal.

CONCLUSION

For the reasons presented above, reconsideration and allowance of the pending claims is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in black ink, appearing to read "Todd J. Iverson", with a long horizontal flourish extending to the right.

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